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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,068	10/13/1999	TAKEHIRO YOSHIDA	862.3067	6943

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/417,068

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This communication is responsive to amendment filed on December 16, 2002.

Applicant amends claims 1-12, and adds new claims 13-18.

#### ***Response to Applicant's Remarks***

Applicant submits that nothing has been found in Okada that would teach or suggest anything relating to detecting a signal delay time and selecting facsimile communication mode via the Internet based on such detected signal delay time.

Since the signal delay time to a calling destination and the predetermined time are not clearly defined and described, the examiner interprets the preprogrammed provider peak times stored in table T2 in Okada as the predetermine time, and the current time in Okada as signal delay time as claimed. When the current time does not overlap with the programmed ISP peak time (the signal delay time is longer than the predetermined time), the e-mail-based facsimile communication mode is selected, and when the current time overlaps with the programmed ISP peak time (the signal delay time is shorter than the predetermined time), In addition, it is noted that "calling destination" is considered the transmitting destination while called destination is considered as the receiving destination.

If the applicant disagrees with the above interpretation, clarification on the signal delay time to a calling destination and the predetermined time is needed.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-6 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Clarification whether "calling destination" means the transmitting destination or the receiving destination.

3. Claim 18 recites the limitation "'the reception capability" in line 3. There is insufficient antecedent basis for this limitation in the claim.

The rejection of claims 1-18 is based on the interpretation that "the calling destination" means the transmitting destination

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-4, 7, 9, 11, 13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Patent No. 6,101,244) in view of Kumar et al (US Patent No. 6,240,445).

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Concerning claims 1, 9, 11, 13, Okada teaches a facsimile apparatus (Fig.1) capable of performing facsimile communication via the Internet comprising communication means capable of performing a first facsimile communication based on e-mail via the Internet and a second facsimile communication not based on e-mail, and control means (CPU 1) for selecting either one of session-based data communication form and e-mail-based data communication form in accordance with a selected transmission mode (automatic selection mode), and causing the communication means to execute facsimile communication in accordance with the selected data communication mode wherein the control means selects the first facsimile communication (email transmission mode) by a first condition (the current time does not overlap with the programmed ISP peak time) and selects the second facsimile communication mode (normal fax transmission mode) by a second condition (the current time overlaps with the programmed ISP peak time), (Figs. 1-4; col. 4, line 26 – col. 5, line 23; col. 6, line 1 – col. 8, line 6).

Okada fails to teach that the second facsimile communication not based on e-mail is also via the Internet. Kumar et al discloses a facsimile reception system 10 (Fig.10) integrates traditional facsimile transmission and reception means with other conventional communication transmission and reception means via Internet. A facsimile message 12 is transmitted from a transmitting facsimile machine 14 across the public switched telephone network (PSTN) 16 to a computer 18. The computer 18 forward a notification message to a user via the Internet 22. Upon receipt of the notification message, the user may choose to have facsimile message 12 down-loaded to a receiving facsimile machine 28. It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of Kumar having communication means capable of performing facsimile communications based on e-mail via the

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Internet and facsimile communications not based on e-mail via Internet to the communication system in Okada since both of them teach a facsimile apparatus capable of performing first facsimile communications mode based on e-mail and second facsimile communications mode not based on e-mail.

Concerning claims 3, 15, Okada discloses the facsimile apparatus discussed in claim 1 above. Okada further teaches detection means (13) wherein the control means selects the e-mail based data communication form when the signal delay time (current time) is longer than a predetermined time (preprogrammed provider IPS peak time), and selects the session-based data communication form when the signal delay time (current time) is shorter than the predetermined time (preprogrammed provider IPS peak time).

Concerning claims 4, 16, Okada further teaches a registration means (5) for registering identification data identifying facsimile communication mode used for facsimile communication and the control means detect the signal delay time when the calling destination is selected and the control means cannot select the identification data corresponding to the selected calling destination from the registration means (col. 4, line 26 – col. 5, line 23; col. 6, line 1 – col. 8, line 6).

Claim 7 is method claim of apparatus claim 1. Claim 7 is rejected in the same rational as claim 1 above.

6. Claims 2, 5, 6, 8, 10, 12, 14, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada and Kumar et al as applied to claim 1 above, and further in view of Yasumoto (Japanese Patent No. JP410032671A).

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Concerning claims 2, 5, 6, 8, 10, 12, 14, 17-18, Okada teaches the setting of the transmission mode to automatic selection (col. 6, lines 4-39), a second detector (12) arranged to detect a reception capability of an external device (Fig.1).

Okada fails to teach that the control means selects the e-mail-based data communication form for an A4 original size and the session-based data communication form for B4 or A3 original size. Yasumoto teaches a facsimile system capable of receiving an electronic mail and facsimile document wherein when it is e-mail, an A4 original size is selected and when it is a facsimile document form, a B4 original size is selected (Fig.14). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of Yasumoto to record an electronic mail or a normal facsimile in different paper sizes in the system in Okada since both of them teach a facsimile system which can transmit and receive facsimile document and email messages. This combination will provide an improved facsimile system which can distinguish an electronic printed paper with a facsimile printed paper based on the size of the papers.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Okutomi et al (US Patent No. 6,211,972) teaches an electronic mail converting apparatus for facsimile.

8. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



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*Anh W. Nguyen*

Madeleine AV Nguyen  
Primary Examiner  
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AV  
March 10, 2003